

William J. Welch, et al.

Application No. 09/823,657

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judicially created doctrine of obviousness-type double patenting. Applicants respectfully traverse this rejection.

Obviousness-Type Double Patenting:

Claims 23-34 were rejected under the judicially created doctrine of obviousness-type double patenting. Specifically, the Examiner alleges that the claims are unpatentable over claims 1-9 of U.S. Patent No. 5,900,360 ("360 patent"). Applicants respectfully disagree.

USSN 08/838,691 issued as the '360 patent. During prosecution, USSN 08/838,691 was subject to a four way restriction in Paper No. 5 mailed December 24, 1997. Claims 1-9 of the 360 patent correspond to group II claims 9-11 and 20-22 of USSN 08/838,691 and are directed to screening methods for detecting concentrations of test protein stabilizing agents effective for improving a phenotypic defect in a cell. Claims 23-34 of the instant application are similar to claims 1 and 3-10 of U.S. Patent No. 6,270,954 B1 ("954 patent") which correspond to group I claims 1-8 of USSN 08/838,691 and are directed to methods of improving a phenotypic defect in a cell that contains a conformationally defective target protein. Applicants understand that since the PTO has previously determined that the subject matter of claims 1-8 of USSN 08/838,691 are patentably distinct from claims 9-11 and 20-22, it is improper to reverse course and reject claims 23-34 of the instant application under the judicially created doctrine of obviousness-type double patenting over claims 1-9 of the '360 patent. Applicants respectfully request that the double patenting rejection be withdrawn.

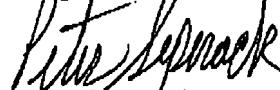
Applicants believe the Examiner meant to reject claims 23-34 of the instant application over claims 1 and 3-10 of the '954 patent. Applicants file herewith, a terminal disclaimer, disclaiming any term of any patent granted on the above reference application, which would extend beyond the expiration date of the full statutory term defined in 35 U.S.C. §§154-156 and §173, as presently shortened by any terminal disclaimer, of prior U.S. Patent No. 6,270,954 B1 issued August 7, 2001.

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CONCLUSION

In view of the foregoing, Applicants believe all claims now pending in this Application are in condition for allowance and an action to that end is urged. If the Examiner believes a telephone conference would aid in the prosecution of this case in any way, please call the undersigned at 415-576-0200.

Respectfully submitted,



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